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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,830	05/30/2001	Volker Lehmann	00 P 21957 US	6111

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EXAMINER
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GORDON, BRIAN R

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/867,830

Applicant(s)

LEHMANN, VOLKER

Examiner

Brian R. Gordon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 2-4-05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 6-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☒ Claim(s) 2 and 6-10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 4, 2005 has been entered.

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 202 A. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Information Disclosure Statement***

2. The information disclosure statement filed 12/17/2002 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

Applicant has yet to provide the examiner with a statement of relevance of the non-English documents as previously requested.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 1 recites the limitation "the flow path" in line 12. There is insufficient antecedent basis for this limitation in the claim.

6. Claim 1 recites the limitation "the surface" in line 18. There is insufficient antecedent basis for this limitation in the claim.

It is unclear what is meant by "an associated well". Does that mean a single well is associated with a plurality of pipettes. The examiner assumes applicant intends for each pipette to interact with a different individual well.

It is also unclear if applicant is intending to claim "a chamber" or a plurality of chambers.

The section of the claim directed to the surface of the liquid channel which comes into contact with the analyte is unclear.

### ***Examiner Comments***

7. In an effort to expedite the prosecution of the instant application, on March 4, 2005 the examiner placed a call to Jeffrey Stone. The examiner informed Mr. Stone of the existing 112, second paragraph issues and presented applicant with a proposed claim to remedy the claim of those issues and further clarify the claim with other minor changes. Applicant did not approve the changes and requested an office action. The proposed changes are given below.

1. (Currently amended): An Apparatus for taking-up aspirating and dispensing liquid analytes, having-comprising a microtitre plate with a plurality of wells for taking-up aspirating an analyte, a plurality of pipettes corresponding with each well, by which an analyte can be withdrawn from an-associated said corresponding wells if the pipettes are is-immersed into the analyte of the associated-corresponding wells, at least one pump, which is coupled to several a plurality of said pipettes in such a way that an analyte can-in each case-be well is transferred sucked-through an-associated corresponding pipette by means of the pump, and analytes can be simultaneously aspirated sucked-out of a plurality of said several-wells or introduced into a plurality of said several-wells by actuating the pump, the apparatus further having-comprising a plurality of analysis chips for analyzing the analyte and a plurality of corresponding chambers, one-wherein said analysis chips correspond respectively with being-in each case-assigned-to-a each well in order to analyze an analyte introduced into the each respective well, wherein each analysis chip comprises a plurality of liquid channels, wherein each analysis chip is arranged between a respective chamber in the a flow path of the analyte from the a well into the a pipette and into a chamber or from the a chamber into the a pipette and into the a well; between-the-pipette-and-the-chamber such that wherein the analyte is sucked transferred through the liquid channels of the analysis chip into the a chamber or out of the a chamber, respectively, and wherein a portion of a surface area the-surface-of-at-least-a-part of the liquid channels of the analysis chips, which-surface-of-at-least-a-part-of-the-liquid-channels-of-the-analysis chips comes into contact with the analyte, said surface area is constructed to allow

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~~designed in such a way that~~ biological material for binding molecules contained in the analyte ~~can~~ to be fixed thereon ~~the surface~~.

In dependent claims 2 and 6-10 insert --The-- before "Apparatus" and change the uppercase "A" to lowercase "a".

In claim 2, insert -further-- before "comprising" in line 1 and delete "having" and insert -comprising- in line 2.

In claims 6 and 7, delete "in which" and insert -wherein- in line 1.

In claim 7 line 2, delete "has" insert -comprises-- and delete "taking up" and insert -aspirate-

In claims 8 and 10, delete "in which" in line 1 and insert -further comprising--.

In claim 8 delete "is" and insert -an-- after "that" in line 2; in line 3, delete "sucked" and insert -aspirate--.

### ***Allowable Subject Matter***

8. Claims 1-2 and 6-10 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

9. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not teach nor fairly suggest a device as disclosed in the above proposed claim.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Muller, Franck; Micklash, Kenneth J. II et al.; Su, Shyh-Haur et al.; Hubbard, Allyn et al.; and Marquiss; Samuel A. et al. disclose liquid handling systems.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is 571-272-1258. The examiner can normally be reached on M-F, with 2nd and 4th F off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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